

REMARKS

Claims 35-51 were pending in the application. Claims 35, 39, 49, 50, and 51 have been amended. Upon entry of these amendments, Claims 35-51 will be pending and under active consideration. Claim 35 is independent.

Applicants submit respectfully that the amendments presented herein are supported fully by the claims and/or specification as originally filed and, thus, do not represent new subject matter.

The specification is amended to add trademark symbols following the recitation of the trademarked term "Carbowax," as required by Examiner.

Claim 35 has been amended to point out more particularly and claim more distinctly that which Applicants regard as their invention by now reciting "single-cell suspension." The amendment of Claim 35 finds support in the specification at page 15, line 9.

Claims 50 and 51 are amended herein to correct their dependency from Claim 35 to Claim 38.

Claims 39 and 49 are amended to recite "antibodies" in place of "the antibody." Support is found throughout the specification as filed.

Applicants respectfully request entry of the amendments and remarks made herein into the file history of the present invention. Reconsideration and withdrawal of the rejections set forth in the above-identified Office Action are respectfully requested.

I. The Double Patenting Rejections

At paragraphs 4 and 5, the Office Action rejects Claims 35-51 as allegedly falling within the judicially created doctrine of obviousness-type double patenting. Applicants traverse respectfully.

Without acquiescing in the propriety of the rejection, Applicants request respectfully that Examiner hold the double patenting rejections in abeyance until allowable subject matter has been determined. At that time, Applicants will file any required Terminal Disclaimer, if appropriate.

II. Rejections Under 35 U.S.C. § 112, First Paragraph

At paragraph 9 of the Office Action, Claims 49 and 50 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention, for the reasons of record. The reasons of record, in sum, allege that monoclonal antibodies OX-43, OX-44, and 374.3 must be readily accessible to the public in order to practice the invention as claimed. Applicants traverse respectfully.

Applicants submit respectfully that antibodies OX-43, OX-44, and 374.3 are not proprietary to Applicants; hence, Applicants are not required to deposit with the ATCC a cell line for producing those antibodies. As indicated at page 34, lines 13-15, OX-43 and OX-44 are readily available to the public from Serotec Corporation of Indianapolis. Likewise, antibody 374.3 was supplied to Applicants by Hixson and Faris of Brown University as indicated at page 37, line 14. Accordingly, Applicants request respectfully that the 35 U.S.C. § 112, first paragraph, rejection of Claims 49 and 50 based on OX-43 and OX-44 be withdrawn,

and that the rejection based on antibody 374.3 be held in abeyance while Applicants determine whether Hixson and Faris have deposited cell lines capable of producing antibody 374.3 with the ATCC.

III. Rejections Under 35 U.S.C. § 112, Second Paragraph

At paragraph 11 of the Office Action, for the reasons of record delineated in subparagraphs a-f, Claims 39-45 and 49-51 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to point out particularly and claim distinctly the subject matter regarded as the invention. Applicants traverse respectfully.

Without acquiescing in the propriety of rejection, and solely to advance prosecution of the present application, Claim 35 is amended herein to add the clarifying recitation, "single-cell" prior to the term "suspension." Accordingly, antecedent basis now exists for the use of the term "single-cell suspension" in Claims 40-45, which depend from Claim 35.

Without acquiescing in the propriety of rejection, and solely to advance prosecution of the present application, Claims 50-51 are amended herein to correct their dependency from Claim 35 to Claim 38, which recites the expression "hepatic cell marker," as required to provide antecedent basis for that term to Claims 50 and 51.

With regard to the rejection presented in subparagraph c, Applicants submit respectfully that antecedent basis for Claim 50 is provided by the amendment, noted above to correct its dependency to Claim 38. Applicants submit respectfully that antecedent basis does indeed exist in Claim 35 as filed for the use of the term "the antibody" in Claim 39, as Claim 35 recites "panning said suspension utilizing *antibodies* specific for hemopoietic cells, mesenchymal cells, mature liver cells, or combinations thereof" (emphasis added). Notwithstanding the foregoing,

Applicants amend Claim 39 herein to recite "antibodies" in place of "the antibody"; there is clear antecedent basis for the use of the term "antibodies" in Claim 39.

With regard to the rejection of Claim 49 for the recitation of "at least one of OX-43 and OX-44," which recitation is allegedly unclear because a monoclonal antibody cannot have more than one specificity, Applicants submit respectfully that the amendment of the term "antibodies" in place of "the antibody" obviates the rejection. "Antibodies" may have more than one specificity.

With regard to the rejections of subparagraphs e and f, Applicants submit respectfully that the characteristics of the recited antibodies that are relevant to the claimed invention are defined in the specification. Although multiple laboratories may use the same nomenclature for different antibodies, Applicants submit respectfully that the particular laboratories which produce the recited antibodies are defined within the specification, and those laboratories cannot be expected to use the same terminology to describe different antibodies from those recited by Applicants.

On this basis, Applicants suggest respectfully that the rejections have been obviated or overcome, and Applicants request respectfully that the 35 U.S.C. § 112, second paragraph, rejection of Claims 39-45 and 49-51 be withdrawn.

IV. Objections To The Specification

At paragraph 7, the Office Action objected to the disclosure of the specification for allegedly failing to acknowledge the trademark status of the trademarked term "Carbowax" and to use generic terminology to accompany the use of the trademarked term. Applicants traverse respectfully.

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As noted above, Applicants herein amend the specification to add trademark symbols and use generic terminology where appropriate, as required by the Examiner. Accordingly, Applicants request respectfully that the objection to the specification be withdrawn.

CONCLUSION


Applicants submit respectfully that the present application is in condition for allowance. Favorable reconsideration, withdrawal of the rejections set forth in the above-noted Office Action, and an early Notice of Allowance are requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3500. All correspondence should be directed to our address given below.

AUTHORIZATION

Applicants believe there is no fee due in connection with this filing. However, to the extent required, the Commissioner is hereby authorized to charge any fees due in connection with this filing to Deposit Account 50-1710 or credit any overpayment to same.

Respectfully submitted,



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